

## REMARKS

### **Pending Claims/Restriction Requirement:**

In this application, claims 1 through 28 were originally filed with the case. Applicant provisionally elected claims 9, 10, 11 for prosecution in this application and applicant affirms that election of Group I subspecies B. as those groups and species are defined in the office action Applicant has added additional claims with this response directed to group I subspecies B. The Examiner is asked to reconsider the election requirements in view of the following comments.

The Applicant regards as a portion of his invention a system that allows the physician to point at a location on a computer screen and unambiguously move a catheter toward that location. In a similar fashion the physician can "reveal" on the screen the current location of the catheter tip if he is at an area of interest. The terms "navigation" and "location" are becoming short hand expressions to capture some attributes of this methodology. Elected claims 9, 10 and 11 are directed to these concepts as are claims 26, 27 and 28. The methods described in Claims 26-28 can be carried out with the structures of claims 9-11. Applicant suggests that these groups be combined for prosecution and further believes that claim blank presented in this amendments generic to both Groups.

Claim 9, 10, and 11 are currently pending. Claims 29-38 have been added. Every effort has been made to confine these claims into the elected group. Kindly call the undersigned to resolve the propriety of the additional claims if the Examiner regards them as "unelected". Entry of these amendments is respectfully requested.

### **Priority:**

The Applicant notes that the Examiner has received the claim made for Small Entity status and acknowledges the claim of codependency through a chain of continuing applications.

### **Drawings:**

The informal drawings submitted with the application were objected to in the Office Action. The Applicant will submit formal drawings for this application after the

indication of allowable subject matter. Applicant will re scale the drawings and insert technical names in the appropriate blocks of the drawing.

#### **Rejection under 35 U.S.C. §112 (paragraph 6)**

In the Office Action, a rejection was made under 35 U.S.C. §112 (paragraph 6) to claims 9 through 11 which have been specifically addressed with the amendments. Specifically the antecedent basis of the various elements has been clarified to more distinctly claim the invention.

#### **Rejection under 35 U.S.C. §101**

Applicant has amended the claims to remove the inferential reference to the heart.

#### **Rejection under 35 U.S.C. §103**

The Examiner has rejected claims 9 - 11 as being unpatentable over Budd in view of Ben-Haim.

The gravamen of the Examiner argument is that Budd teaches a heart chamber mapping system and that the Ben Haim reference teaches a display system (activation map). The Examiner concludes that one of ordinary skill would find the combinations of claims 9, 10, 11 obvious.

Actually claim 9 is fully supported by the incorporated disclosure of Budd 5,297,549 which has been copending with the additional disclosure in the present case. For example the single catheter of Budd '549 has passive and an active electrode 3 coupled to the signal generator 32. The passive signals are digitized and used to display a map on the workstation. Clearly a claim supported by the incorporated reference which predates the applied reference (Budd '611) demonstrates that the applicant possessed the invention before the effective filing date of Budd '611. Thus there is evidence in the file that the Budd '611 is not prior art to applicants claims 9 et seq. Applicant unfortunately has no case law to cite in this argument but invites the Examiner to reconsider this rejection. These arguments would not hold for a reference which is prior art to Budd 5,297,549 having an effective filing date Sept 22 1992. Applicant sees no double patenting issue since the inventions claimed in the present case are not identical to or obvious in view of the prior case.

### CONCLUSION

All of the claims remaining in this application should now be seen to be in condition for allowance. The prompt issuance of a notice to that effect is solicited.

Respectfully Submitted,  
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By its attorneys:

Date:

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